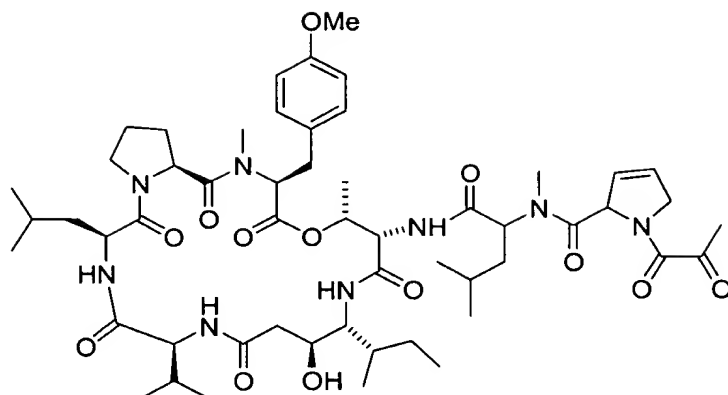


Remarks

The Examiner has required restriction to one of three groups of inventions, Groups I-III, under 35 U.S.C. § 121. Group I, represented by claims 1-13, 19-21, and 27-38, is drawn to a tamandarin or didemninn compound having the structure of Formula I and a composition comprising said tamandarin or didemninn analog. Group II, represented by claims 14-18, 22-26, and 39-43, is drawn to a method of inhibiting protein synthesis, inhibiting growth of a cell, inhibiting proliferation of a cell, inhibiting tumorigenesis in a cell, or enhancing apoptosis in a cell by administering a tamandarin or didemninn analog of the present invention. Group III, represented by claims 44-55, is drawn to a method of making a tamandarin or didemninn analog of the present invention. The Examiner has also requested an election of a single disclosed species under 35 C.F.R. § 121.

Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-13, 19-21, and 27-38. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants also provisionally elect the species having the structure shown in claim 1 wherein R¹ is (N-methyl)leucine-dehydro-proline-pyruvate; R² is *p*-methoxyphenyl; R³ is methyl; R⁴ is an isoleucine side chain; X is NH; Y is H; and R¹⁰ is a leucine side chain. In accordance with the Examiner's request, Applicants provide the structure of the elected species.



The Examiner also requested an election of "a single method claim of Group II using the single compound." See Office Action, p. 4. Applicants hereby elect the method of inhibiting protein synthesis, recited in claim 14.

The Manual of Patent Examining Procedure ("MPEP") § 803 (Original Eighth Edition, August 2001, Latest Revision February 2003), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02)." Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made without serious burden. Further, searches that may require the examination of different classifications, separate commercial databases, automated patent system (text) searches are not a proper standard for restriction requirement.

In the present case, Applicants respectfully assert that the search of restriction Groups I-III does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups.

Applicants note that the claims of Group I are related to the claims of Groups II and III in a product/process relationship. The MPEP provides guidance in examining applications in which "product and process claims drawn to independent and distinct inventions are presented in the same application" MPEP § 821.04. "[I]f applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." *Id.* Accordingly, even if the Examiner concludes that the claims of Groups I-III represent independent and distinct inventions, Applicants believe that rejoinder of the process claims, *i.e.*, claims of Groups II and III, is appropriate upon finding of allowable product claims, *i.e.*, claims of Group I. In the present case, Applicants have provisionally elected the product claims of Group I. Applicants thus reserve the right to rejoin the process claims of Groups II and III upon finding that the claims of Group I are allowable. Such rejoinder is consistent with the procedures set forth in the *Official Gazette* notice dated March 26, 1996. *See* 1184 OFFICIAL GAZETTE PAT. OFF. 86.

Applicants submit that in the present case, restriction to one of three groups of inventions, as required by the Examiner, is improper. Therefore, the claims of Groups I-III should be examined together. In the event that the Examiner concludes that restriction is appropriate, Applicants request that process claims, *i.e.*, claims of Groups II

and III, be rejoined upon finding that the product claims, *i.e.*, the claims of Group I, are found allowable.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Respectfully submitted,

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